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EXAMINER

SHAN, APRIL YING

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

***Response to Arguments***

Applicant's arguments filed on March 12, 2008 have been respectfully and fully considered, some of them are persuasive and some are not.

Applicant's arguments are summarized as:

- a. IDS document "Hot Spots that can turn a street corner into an office" submitted on April 3, 2008 complies with 37 C.F.R. 1.98 (a)(3) (See remark page 2)
- b. Takada and Jun are hindsight reconstruction (See remark pages 3- 6)
- c. Dependent claims are allowable due to dependency (See remark page 6)

**In response to argument 'a'**, the Applicant's explanation is persuasive. Thus, IDS document "Hot Spots that can turn a street corner into an office" submitted on April 3, 2008 is considered by the examiner.

**In response to argument 'b'**, the examiner respectfully disagrees. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The examiner further respectfully points out a person with ordinary skill in the art is someone having common sense and ordinary creativity (*KSR v. Teleflex* 550 U.S., 127 S. Ct. 1727 (2007)) will easily recognize that the method/system recited in claims 1

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and 17 are merely "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR* at 1739.

**In response to argument 'c'**, the examiner respectfully traverses. Applicant's argument for claims 1 and 17 as discussed above are traversed and therefore, the Applicant's arguments for dependent claims based on dependency on claims 1 and 17 are traversed and it is not allowable.

The examiner also respectfully points out Guidance of "Process" under 35 USC 101 in view of the Court of Appeals for the Federal Circuit in *In re Bilski*, Appeal No. 2007-1130 was provided to the examiner and the public in January 2009, in which it requires a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The Applicant is respectfully advised to check whether the method claims 1-3, 6-11 and 13-16 are qualified as a statutory process under *In re Bilski* by positively tied to a particular machine that accomplishes the claimed method steps or transforms underlying subject matter.

/April Y Shan/

Examiner, Art Unit 2435

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435